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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/899,727

07/05/2001

John E. Jones

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EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/899,727	<b>Applicant(s)</b> JONES, JOHN E.	
	<b>Examiner</b> Lalita M. Hamilton	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 19-35, 38-76 and 112-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 19-35, 38-76 and 112-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                            | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to the reply filed on August 7, 2007.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 75 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 75 recites a method. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3691

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 25-32, 34-35, 38-48, 71-76, and 115-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over York (5,926,392) in view of Geer (5,930,778).

York discloses the invention substantially as claimed (col.1, line 50 to col.2, lines 65); however, York does not disclose the a second computer at the payee bank communicatively coupled to the first computer and adapted to receive the at least one image of the check and the at least one image of the invoice from the first computer, wherein the first computer is further adapted to transmit funds in the amount of the check to the payee bank and the second computer is adapted to receive the funds and to credit the payee's account for the amount of the funds. Geer teaches the clearing of financial instrument and coordination with the invoice comprising the a second computer at the payee bank communicatively coupled to the first computer and adapted to receive the at least one image of the check and the at least one image of the invoice from the first computer, wherein the first computer is further adapted to transmit funds in the amount of the check to the payee bank and the second computer is adapted to receive the funds and to credit the payee's account for the amount of the funds (col.4, line 45 to

Art Unit: 3691

col.5, line 45; col.9, line 50 to col.10, line 7; and col.14, lines 40-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Geer within York for the motivation of storing the images and transferring funds to the appropriate accounts.

Claims 7-10, 19-24, 33, 49-70, and 112-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over York and Geer as applied to claims 1 and 48 above, and in further view of Norris (6,105,007).

York discloses and Geer teaches the invention substantially as claimed; however, neither York nor Greer discloses or teaches the following limitations taught by Norris. Norris teaches automatic financial account processing comprising wherein one of the first computer or the document scanning system is further adapted to obtain an authorization agreement from the customer (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); the authorization agreement is obtained verbally from the customer (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); the authorization agreement is displayed to the customer on a video screen (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); 20. an electronic signature pad and an electronic pen, the electronic signature pad adapted to receive a signature from the customer (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); a button on the video screen wherein the customer activates the button to execute the authorization agreement (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); the authorization agreement is a form signed prior to the transaction occurring (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); the form authorizes one transaction (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); the form authorizes a

Art Unit: 3691

plurality of transactions (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); obtaining an authorization agreement from the customer to debit the first financial account (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); obtaining an authorization agreement occurs prior to inserting the check in the input receptacle (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); wherein checking for indicia of cancellation is done prior to obtaining the executed authorization agreement (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); manually stamping the authorization agreement on the document (col.2, line 35 to col.4, line 40 and col.7, lines 38-52) wherein stamping further includes stamping a promise to pay as well as an authorization agreement on the document (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); imprinting the authorization agreement on a receipt (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); manually stamping the authorization agreement on the receipt (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); displaying the authorization agreement to a customer on a video screen (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); providing an electronic signature pad and an electronic pen for receiving a signature from the customer to execute the authorization agreement (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); providing a button for the customer to activate the displayed authorization agreement (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); obtaining the executed authorization agreement comprises obtaining an executed authorization agreement for a single transaction (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); obtaining the executed authorization agreement comprises obtaining an executed authorization agreement for a plurality of transactions (col.2, line 35 to col.4,

Art Unit: 3691

line 40 and col.7, lines 38-52); inscribing the check with an indicia of cancellation (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); transmitting an image of the cancelled check to the customer (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); a printer associated with either the first or second computer, the printer operable to print a substitute check from the at least one image of the check (col.2, line 35 to col.4, line 40 and col.7, lines 38-52); and including printing at either the payor or payee financial institution of a substitute check from the image of the check (col.2, line 35 to col.4, line 40 and col.7, lines 38-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Norris within York and Greer for the motivation of allowing the customer to endorse and reprint the check.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10, 19-35, 38-76 and 112-116 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lalita M Hamilton/  
Primary Examiner, Art Unit 3691